

REMARKS

Prior to the present Office Action, claims 1-29, 38 and 66-81 were pending in this application, with claims 80 and 81 being withdrawn as reading on a non-elected invention

Claims 1, 2, and 17 stand rejected under 35 U.S.C. §112, second paragraph, as being
5 indefinite for lacking antecedent basis. Accordingly, the amendments shown above, including one in claim 19, are believed to address the lack of antecedent basis issue.

Claims 1-11, 13-28, 38, 66-70, and 78-79 stand rejected under 35 U.S.C. §102(e) as being anticipated by Conlon, et al. (USPN 2004-0254537).

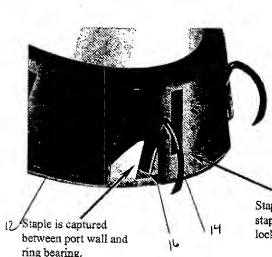
10 Applicants first wish to note that only a portion of the disclosure in Conlon, et al. is 102(e) prior art. Conlon, et al. was filed on December 19, 2003 claiming priority to Provisional Application 60/478,763 (hereinafter “the Conlon Provisional”), which was filed on June 16, 2003. Please be aware that later filed Conlon, et al. includes additional material that was not in the earlier filed Conlon Provisional.

15 The present application is a National stage application of PCT/US05/01958, filed January 21, 2005, which claims priority to U.S. Provisional Application No. 60/538,674 filed January 23, 2004. The present application is also a continuation-in-part of U.S. Application No. 10/562,964, having a 35 U.S.C. §371 date of December 30, 2005 as a National stage application of PCT/US04/30053, filed September 15, 2004, which claims priority to U.S. Provisional
20 Application No. 60/503,074 filed September 15, 2003 (hereinafter “Provisional 1”) and to U.S. Provisional Application No. 60/538,674 filed January 23, 2004 (hereinafter “Provisional 2”). Each of the priority documents have been incorporated herein by reference in their entireties. Please note that a Petition to correct the priority claim of the present application was submitted on May 19, 2009, and is presumed entered for the purpose of this response.

25 Consequently because of the priority of the present application (as explained in the paragraph above), it is clear that subject matter from Conlon, et al. (filed December 19, 2003) that is **not** disclosed in the Conlon Provisional (filed June 16, 2003) **cannot** be used as 102(e) prior art against any claims in the present application that derive support from Applicants Provisional 1 (filed September 15, 2003). Indeed, such is the case here, as will be explained.

Discussion of Claim 1

Claim 1 provides a method of securing a device to bodily tissue comprising providing a device having an associated attaching means. Notches or openings in the attaching means comprise a fastening means pivotally attached to the housing. The method includes positioning the device and attaching means on the bodily tissue and using a delivery system to rotate the fastening means from a first position, and locking the fastening means into the second position by a locking tab. This is clearly seen in Applicants Provisional 1 in Figs. 3 and 4 including notations, seen below, and as described on page 7, lines 25-26.



Staple flexes to allow staple to pass into locked position.

Fig 3

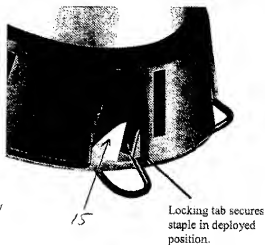


Fig 4

The method including locking the fastening means into the second position by a locking tab is **not** disclosed in the Conlon Provisional, and therefore Applicants believe claim 1 is allowable over Conlon, et al. Indeed, Applicants assert that Conlon, et al. itself does not disclose the method including locking the fastening means into the second position by a locking tab. Examiner Fisher states that in Conlon, et al. “the fastening means (30) are locked into the second position by a locking tab (22a).” However, element 22a in Conlon, et al. is a “portion 22a of flange 22 [that] extends generally radially outward,” as described in paragraph [0050] with reference to Fig. 2. As explained further in the same paragraph, the flange 22 carries a fastener support 34 having a pin 32 about which a fastener 30 is disposed to rotate in a respective radial plane. The flange portions 22a merely extend the flange radially outward to provide structure about which the fasteners 30 rotate. Moreover, the discussion of the flange portion 22a is absent

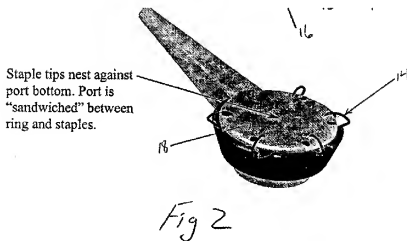
in the Conlon Provisional, and the same structure is referred to as a brim 28 having "journal boxes 42" about which hooks 30 rotate.

Clearly in Conlon, et al. there is no locking function or any locking tab. Indeed, there is no mention of such a function in Conlon, et al., and in fact in several places in the Conlon Provisional the reversibility of the hooks 30 is highlighted (see paragraphs [010] and [076] in the Conlon Provisional). Applicants therefore believe that claim 1 is allowable over Conlon, et al., as well as and over the earlier Conlon Provisional.

Dependent claims 2-11, 13-16, and 38 are believed allowable as depending from allowable claim 1. Furthermore, these claims add further aspects that are not shown in Conlon, et al., or are supported by Provisional I and not disclosed in the Conlon Provisional.

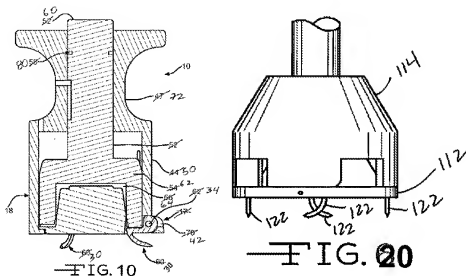
Discussion of Claim 17

Claim 17 recites an attaching means for attaching an associated device to bodily tissue. A housing surrounds a perimeter of the device and has a plurality of notches or openings in which fastening means pivot and rotate from a first position to a second position. Each fastener has a sharp tip for piercing tissue which is located above a bottom surface of the housing in the first position and rotates below the housing to nest against the bottom surface of the housing in the second position. See Fig. 2 of Provisional I for support:



Since claim 17 is supported by Applicants Provisional I (filed September 15, 2003), later filed Conlon, et al. can not be 102(e) prior art with regard to present claim 17. Additionally (as explained below) the subject matter of claim 17 is also not disclosed by the Conlon Provisional.

Thus, the Conlon Provisional discloses several pivoting fasteners, including those shown in Figs. 1-14 and in Figs. 16-20. In each of these, the fasteners rotate only about 90° and the tips thereof extend only downward into the tissue. See, for example, the deployed configurations in Figs. 10 and 20, copied below from the Conlon Provisional :



On the other hand present vlain 17 provides a fastening means that secures the tissue between the fasteners and the housing and provides a greater hold by rotating so far that the tips nest against the bottom surface of the housing. This is not shown nor taught in the Conlon Provisional in which the fasteners as shown above are not capable of further rotation. Therefore Claim 17 and its dependents are allowable over Conlon, et al.

Discussion of Claim 66

Claim 66 recites a method of securing a device to bodily tissue. The device has a housing that comprises a plurality of tissue attaching fasteners pivotally mounted thereto and acted on by a rotating disc *in the device* to displace each fastener from a first position above a lower surface of the device to a second position below the lower surface. (*italics added*) A delivery system covers the device and is activated to rotate the disc therein such that the attaching fasteners are each pivotally rotated from the first position to the second position.

On page 4 of the Office Action, Examiner Fisher identifies in Conlon, et al. a “rotating disc (70)...for rotating said fastening means (30) from said first position to said second position.” Applicants note that element 70 as seen in Fig. 9 of Conlon, et al. is an “end 70 of

cylindrical portion 68” of a plunger 48. The plunger 48 advances linearly to act on the pivoting fasteners 30, as seen in Fig. 13. See paragraphs [0058]-[0059]. Importantly, end 70 is not a disc, it does not rotate, and it is not in the device being attached. Therefore, Applicants assert that claim 66 is allowable over Conlon, et al.

Claims 12, 29, and 71-77 stand rejected under 35 U.S.C. §103(a) as being obvious in view of Conlon, et al. (USPN 2004-0254537). Without conceding the merit of these rejections, Applicants assert that claims 12, 29, and 71-77 depend from allowable claims, as explained above, and are therefore also allowable.

Based on the foregoing remarks and amendments Applicants believe claims 1-29, 38 and 66-81 are in condition for allowance and such action is solicited.

Respectfully submitted,

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